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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER	
LANEAU, RONALD	
ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,969	Applicant(s) MEYER ET AL.	
	Examiner Ronald Laneau	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-27,29-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-27,29-34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on 3/10/06 has been entered. Claims 5, 28, 35 and 37 are canceled and claims 1-4, 7-27, 29-34 and 36 are now pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-10, 13-16, 18, 24-27, 33, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) and further in view of Miyamoto (US 6,456,391 B1).

Parulski teaches a method of receiving a least one digital image from memory of an imaging device (col. 13, lines 43-45), performing a point-of sale transaction for storing a least one digital image at a remote site (see abs., lines 8-10; the uploading is done to a remote site from the electronic database). Uploading can be done via the Internet and the remote storage site would include an image storage web site (col. 8, line 67 to col. 9, line 4, fig. 2). Parulski further teaches that removing memory accesses the digital image from the imaging device and inserting the memory into a memory reader (Fig. 29 (0012)).

Safai discloses displaying a price for storing the at least one digital image at the remote site; prompting a customer for payment of the price; receiving a payment for storing the at least

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one digital image at the remote site; storing the at least one digital image at the remote site (col. 25, lines 45-50 and col. 27, lines 30-43).

Neither Parulski nor Safai teaches printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored. The printing of the thumbnail on a printing paper is evidence that it can also be used on a sales receipt that would include the price paid for storing the image at the remote site and the date the payment was received as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the well-known step of receiving and accessing at least one digital image by reading memory that had been removed from the digital imaging device as already taught in Safai for the purpose of being able to have the ability to access all types of digital cameras and thus be able to service all customers at the kiosk thereby maximizing revenues and profits.

It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view to confirm storage of the digital image or documents as taught by Miyamoto into the combined teachings of Parulski and Safai because it would maximize the efficiency of storing and indexing electronic documents.

Claims 19-21 are rejected for the same reasons set forth in the method claim above.

As per claims 8 and 9, Safai discloses that the remote site is a server/image storage web site (col. 25, lines 45-50); storing digital images takes up space and that the uploading of the

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stored information directly to a personal computer required the availability of such a computer when using the capture device can be cumbersome or inconvenient; convention digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data (see fig. 7).

Furthermore, image storage web sites are connected to a remote server were well-known in the art for just these purposes, i.e. Shutteriy.com, Fujifilm.net, clubphoto.com, photoaccess.com and Applicant's own site cartoga.com, among many others.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized a remote site of an image storage web site, which would have incorporated a server as already taught in Safai because the skilled artisan would have recognized that this business practice accrues the advantages explicitly taught by Safai.

As per claims 30-32, the combined systems of Parulski, Safai and Miyamoto do not expressly teach a method wherein uploading the at least one digital image to the remote site further comprises mailing the recordable medium to the remote site, wherein the recordable medium is a CD-ROM and wherein the recordable medium is a tape but it is obvious that having a CD ROM and a tape as a recording medium is well known in the art and one would be able to mail it to a remote site after storing it in a CD ROM or a tape as claimed.

Parulski does not teach printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction

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including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored. It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (equivalent to a digital camera where the image data is received by reading by reading memory that has been removed from the camera);

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to the uploading done to a remote site the image server as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to the uploading is done to a remote site from the electronic database; See abs., transfer includes docking station, modem, transceiver, cable telephone line – all electronic forms).

Parulski teaches an article for a machine having a processor (CPU for the server) and an interface (the software on the website that enables a program to work with the user/input device (the user interface, which can be, a command-line interface, menu-driven, or a graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site (how the web site operates as set forth in the method, it could not operate without a computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

Parulski teaches a digital image display device 500 that produces color LCD, from image provided on a removable memory card 530 or via a host interface 542 from a host computer 540 (col. 13, lines 46-50).

Neither Parulski nor Safai discloses printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

4. Claims 4, 17, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) and further in view of www.telepix.com

Neither Parulski nor Safai teach printing a sales receipt for the transaction identifying information about the digital images that were paid for. www.telepix.com teaches receiving at least one digital image from memory of an imaging device, storing at least one digital image at a

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remote site (image storage web site) and allowing it to be accessed, uploading digital images to the remote site via the internet from a wide variety of digital camera memory cards, printing a sales receipt for transactions that occur at the kiosk (Photostation 2000 - automatic job order logging and receipt printing). www.telepix.com further teaches that the kiosk is a mini-kiosk (has a memory card reader - external compact flash, smart media, PCMCIA card reader), a processor responsive to the card reader and programmed to perform a point-of sale transaction and sends digital images to a remote storage site (400 MHz AMD K6 processor - automatic job order logging and receipt printing; internet connectivity to Telepix Photo Network - display, share, download, email and print), a data communication device responsive to the processor for sending the digital images to the remote site (Integrated 10/100 Ethernet network port, Dual Universal Serial Bus, Supports dial-up, ISDN, ADSL or cable modem connectivity), at least one device, coupled to the processor, for entering payment information (wireless infrared keyboard for enhanced security in setup and administration, easy to use touch screen user interface), a receipt printer coupled to the processor, whereby the processor can command the printer to print out receipts of the transactions (receipt printing).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of providing a printed sales receipt through a printer in the mini-kiosk as taught in www.telepix.com in the combined system of Parulski and Safai as this business practice provides the customer with necessary information, saves time spent by a customer in making purchases, enhances customer satisfaction and entices customers to stay with the business. Moreover, it would have been obvious to one having ordinary skill in the art at the

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time of the invention to have added identifying information about the digital images that were paid for to the receipt for the reasons set forth above.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) further in view of Miyamoto (US 6,456,391 B1) as applied to claims 1 and 11 above, and further further in view of Eastman Kodak: Kodak to acquire 51% state in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

Parulski, Safai and Miyamoto teach as set forth above. However, neither Parulski nor Safai nor Miyamoto teach that the owner of the kiosk has a fee agreement with the owner of the storage site. M2 Presswire teaches that PictureVision built the leading franchise at retail, i.e. digital image storing. Franchising is a form of a fee agreement with an owner of a remote storage site. M2 Presswire further teaches that this form of transaction based processing gives customers more benefits by allowing them to share their photos quickly and easily through the combined service, i.e. retail kiosks and the owned remote storage. Moreover, it is well known in the business art that if one does not own space one pays for it, i.e. rents it, leases it, or buys it. The same is true of a service that one provides to a customer. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of having the owner of the kiosk have a fee agreement with the owner of the remote storage site in the combined system of Parulski, Safai and Miyamoto as taught in M2 Presswire because the skilled artisan would have recognized that this business practice is a mechanism by which the remote storage site stays profitable and stays in business, would follow in the internet world from the business community where competition is sometimes world wide and customers have a greater

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influence on the success of a business and provides a valuable service to the kiosk owner by avoiding the need for him incur the costs of setting up his own web site for his customers, when he can pay a low fee for a site that is already set up and can be off-set in other negotiated ways through the franchised licensing agreement.

Response to Arguments

6. Applicant's arguments filed on 3/10/06 have been fully considered but they are not persuasive.

Applicant argues that Miyamoto's index print of thumbnail images is not a sales receipt. In response to Applicant's arguments, although Miyamoto does not explicitly disclose a sales receipt but one of ordinary skill in the art does not anticipate any problem for Miyamoto's system to print a thumbnail image on a sales receipt as claimed. Applicant further argues that neither Parulski nor Miyamoto discloses "sending digital images from a user's digital camera to a remote storage site but the newly added reference (Safai) is used to disclose such features. All other arguments are moot in view of Safai (see above rejection). As a result, claims 1-4, 7-27, 29-34 and 36 are finally rejected.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Ronald Laneau

Ronald Laneau

Examiner

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5/18/06

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